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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,849	04/12/2004	Russell A. Firestone III	36707-502	1735
64046 7590 12/08/2009 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER BROOKS, MATTHEW L.				
ART UNIT 3629		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,849

Applicant(s)

FIRESTONE, RUSSELL A.

Examiner

MATTHEW L. BROOKS

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is in response to the filing on 24 November 2009.

Status of Claims

2. Original claims 1-24 are currently pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 15-18** are rejected under 35 U.S.C. 102(e) as being anticipated by Pub.

No.: US 2003/0149526 A1 (Zhou).

5. With respect to **claim 15** : Zhou teaches A system ~~for tracking medical or toxic waste~~ comprising:

(a) a **first container** adapted to hold untreated medical waste, the first container having a wireless tracking device attached thereto (See Fig 13, Portable Sensor Units AND [0206] "the system may be applied to monitor the position of hazardous waste such as that contained within mobile or stationary containers... specifically, portable devices may be affixed to drums carrying waste, and may include sensors both external and internal to the drum" AND Note: the containers are adapted to hold hazardous

waste, untreated medical waste is a type of hazardous waste, therefore the limitation as is, is merely intended use of system), the wireless tracking device configured with a global positioning system for tracking (Fig 13 AND [0026] "Furthermore, where the waste containers are mobile, the portable units include location-tracking components, such as GPS receivers described above."); and

(b) a **tracking station** capable of monitoring the movement of the medical waste by tracking the wireless tracking device (Fig 13 "ASP" AND [0207] "The positioning information and the output from the sensors are transmitted to the ASP via a wireless communication system. The ASP, in turn, monitors the position and sensor outputs. In one embodiment, the ASP makes such position and sensor information available on a secure website via the Internet. Potential end-users having access to such website may include local and Federal regulatory agencies, residents, and other end-users").

6. With respect to **claim 16** : Zhou teaches, further comprising at least one handheld reader ([0229] "The Base Unit's RF reader interrogates the Tag(s) ... and collects data from each Tag." AND "If the Base Unit has an internal power source, it could stand alone," AND/OR [0025] access data with PDA or other mobile device).

7. With respect to **claim 17** : Zhou teaches further comprising a satellite or cellular station (See Fig 13, 15 satellite AND [0292] "Transceiver transmits the data collected (position data and data from tag) to the cellular satellite. Cellular satellite transmits the data to ASP.").

8. With respect to **claim 18** : Zhou teaches further comprising a computer to track said container ([0207] "The positioning information and the output from the sensors are transmitted to the ASP via a wireless communication system. The ASP, in turn, monitors the position and sensor outputs. In one embodiment, the ASP makes such position and sensor information available on a secure website via the Internet. Potential end-users having access to such website may include local and Federal regulatory agencies, residents, and other end-users" AND [300] "The sensor receives data regarding a particular parameter of the object wished to be monitored. The position data and the sensor data are sent or are otherwise available to the transceiver for transmission to a computer or base station.")

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
11. **Claims 1-14 and 19-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhou in view of "Hospitals Use Alternative Off-Site Methods"; Barlow, Rick Dana. Hospital Material Management. Ann Arbor: Aug 1992. Vol 17, Iss. 8; pg. 14, 4 pgs) (herein after Stericycle).
12. With respect to claim 1 : Zhou discloses A method comprising: (a) **monitoring a** movement of a first container, the first container having a wireless tracking device attached thereto (See Fig 13, Portable Sensor Units AND [0206] "the system may be applied to monitor the position of hazardous waste such as that contained within mobile or stationary containers... specifically, portable devices may be affixed to drums carrying waste, and may include sensors both external and internal to the drum"),
(b) the wireless tracking device configured with a global positioning system to allow tracking from a waste generating facility to a waste treatment facility using the wireless tracking device (Fig 13 AND [0026] "Furthermore, where the waste containers are mobile, the portable units include location-tracking components, such as GPS receivers described above.").

Zhou fails to explicitly teach that the specific hazardous waste transported of untreated medical waste.

However, Stericycle teaches that as early as 1992 (over a decade before the earliest filing date of the instant application) that hospitals were using "alternative off-site disposal of *infections medical waste*" (see Abstract, lines 1-2; infectious medical waste leaving the hospital is considered the equivalent to "*untreated medical waste*").

medical waste is a hazardous material and is treated in a certain manner according to federal regulations (p. 4 “regulatory pressure to render waste unrecognizable”).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine to two references to monitor location at all times the transfer of medical waste between generation and disposal for the advantage of ensuring regulatory compliances.

13. With respect to **claim 2** : the combination teaches, further comprising: monitoring the return of the first container from the waste treatment facility to the waste generating facility with the wireless tracking device (Zhou teaches that the tags are embedded or permanently affixed; [0206] “the system may be applied to monitor the position of hazardous waste such as that contained within mobile or stationary containers... AND Stericycle teaches that recycling/medical waste treatment companies where distributing/shipping OR “returning to” a waste generating facility a specialized containers to hospitals (“Steritubs, which are then distributed to hospital clients...” (bottom of p. 2) and that the hospital “receives plastic containers as part of the contract” (p.2, second full paragraph NOTE also, these claims are rendered obvious by what was known to one of ordinary skill at the time of the invention, monitoring medical waste from cradle to grave was well known).

14. With respect to **claim 3**: the combination teaches, wherein monitoring comprises scanning the wireless tracking device with a handheld reader ([0229] “The Base Unit's RF reader interrogates the Tag(s) ... and collects data from each Tag.” AND “If the

Base Unit has an internal power source, it could stand alone," AND/OR [0025] access data with PDA or other mobile device).

15. With respect to **claim 4** : the combination teaches, further comprising uploading tracking data to a monitoring station (See Fig 13, 15 satellite AND [0292] "Transceiver transmits the data collected (position data and data from tag) to the cellular satellite. Cellular satellite transmits the data to ASP.").

16. With respect to **claim 5** : the combination teaches, wherein the medical waste is segregated according to type prior to putting it in the medical waste container (Stericycle; p. 3, 4th paragraph, separate at front end).

17. With respect to **claim 6 and 19**: the combination teaches, further comprising weighing the first container with prior to treating the waste (Stericycle; p. 2, subtracts weight of containers, Further more this step is well known to ordinary skill in the art to weigh waste containers to know how much to charge for proper disposal, see below)

18. With respect to **claim 7** : the combination teaches, further comprising determining the amount of waste in the container (Stericycle; p. 2, subtracts weight of containers,).

19. With respect to **claim 8** : the combination teaches, further comprising calculating how much to charge a customer based on the type of waste and the weight of the waste (Stericycle; p. 2; 2nd paragraph "infectious waste" is the type and charges per pound).

20. With respect to **claims 9 and 10**: the combination teaches, further comprising billing the customer based on type and weight (Stericycle; p. 2, 2nd paragraph; the

automation of such and including an invoice would have been obvious to one of ordinary skill).

21. With respect to **claim 11 and 21** : the combination teaches, further comprising supplying a second container, the second container adapted to hold treated medical waste (Stericycle; p. 2, bottom of page "steritubs").\

22. With respect to **claim 12**: the combination teaches, further comprising tracking the second container to a landfill or recycling center (Zhou Fig 13 AND Stericycle is a recycling center).

23. With respect to **claims 13 and 20**: the combination teaches, further comprising supplying the customer with an invoice, the invoice including confirmation of the delivery of the waste to the landfill or recycling center (Stericycle; p. 2, 2nd paragraph; the automation of such and including an invoice would have been obvious to one of ordinary skill AND Official Notice of such is taken that this was known in the art as shown previously by Hassett, C1, 65-bottom; "confirm delivery after a shipment has been received AND C2, 1-10 "verify receipt or delivery of load at an end point..." AND Hassett teaches generation of reports C2, 5-10 and to include a "manifest" of confirmation of destruction was known and thus obvious to one of ordinary skill at time of invention).

24. With respect to **claims 14 and 22** : the combination teaches, wherein the wireless tracking device operates at radio frequencies (Zhou, [0022] -"radio").

25. With respect to **claims 23** : the combination teaches, wherein the segregated waste comprises sharps containers (Stericycle; p. 2 bottom of page, "syringes").

26. With respect to **claims 24** : the combination teaches, further comprising processing the sharps containers (Stericycle; p. 3, separate at front end) and sending the processed sharps containers to a recycling facility (same, "so Stericycle can recycle...").

Response to Arguments

27. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached 1449. And particularly the marked up attached copies of Patent Numbers **5,532,928 (Stanczyk)** which teaches a truly enabled method for accounting for waste, particularly columns 8-9 for the billing of such disposal. Examiner has pulled the previous enablement 112 1st based on Applicants arguments that one of ordinary skill would know. Further see marked up copy of Patent US **6,729,540 (Ogawa)** showing much of the prior art involved in tracking medical waste. And of course Applicant is advised to see **5,347,274 (Hassett)** applied in the previous rejection, which would be a 102, and even shows uploading data to a satellite link [c5, 28-35] but fails to teach that the data is "positional".

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. BROOKS whose telephone number is (571)272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John G. Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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12/3/2009

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